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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-------------------------------------|-------------|----------------------|---------------------|------------------|
| 09/994,492 | 11/26/2001 | Dana C. Mears | ZM0 442 | 1101 |
| 43963 | 7590 | 03/03/2005 | EXAMINER | |
| ZIMMER TECHNOLOGY - BAKER & DANIELS | | | PHILOGENE, PEDRO | |
| 111 EAST WAYNE STREET, SUITE 800 | | | ART UNIT | PAPER NUMBER |
| FORT WAYNE, IN 46802 | | | 3732 | |

DATE MAILED: 03/03/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

SP

| | | | | |
|------------------------------|------------------------|--|---------------------|--|
| Office Action Summary | Application No. | | Applicant(s) | |
| | 09/994,492 | | MEARS, DANA C. | |
| | Examiner | | Art Unit | |
| | Pedro Philogene | | 3732 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 February 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6,8-14,16-18,21-23,25-27,30-35 and 43-47 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6,8-14,16-18,21-23,25-27,30-35 and 43-47 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 02/10/05 has been entered.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1,2,4,5,8,13 are rejected under 35 U.S.C. 102(b) as being anticipated by Rubin (3,716,057).

With respect to claims 1, 4,8, Rubin discloses a cutter comprising a handle (10) a head (12) having a distal end with a blade (14), the head connected to the handle, the having a head thickness; and spacer means (16) connected to the head; the blade recessed from the spacer means, the spacer means having a spacer means thickness, the spacer means thickness greater than the head thickness; as set forth in column 1, lines 25-33.

A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to

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patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 312 F.2d 937, 939, 136 USPQ 458, 459 (CCPA 1963).

With respect to claims 2,5,13, Rubin discloses all the limitations; as set forth in column 1, lines 5-37, column 2, lines 2-36; and as best seen in FIGS.1-2.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 3, 6, 9, are rejected under 35 U.S.C. 103(a) as being unpatentable over Rubin (3,716,057).

With respect to claims 3,6,9, it is noted that Rubin did not teach of joint spacer having a thickness of about 31 millimeters; and, an extension extending 30 degrees away from the radius of curvature; as claimed by applicant. However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to reach an optimum value since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 F. 2d 272,205 USPQ 215 (CCPA 1980). It also has been held that where the general

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condition of a claim is disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233.

Claims 10-12,14,16-18,21-23,25-27,30-35, 43-47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rubin (3,716,057) in view of Stryker (3,221,744).

With respect to the above claims, it is noted that Rubin discloses all the limitations; except for a head having a radius of curvature; as claimed by applicant. However, in a similar art, Stryker, column 2, lines 39-54, evidences the use of a surgical knife head with a radius of curvature to accommodate different amounts of curvature and adapt its structure for use in performing any surgical operations.

Therefore, given the teaching of Stryker, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the head of Rubin; as taught by Stryker, to accommodate different amounts of curvature and adapt its structure for use in performing any surgical operations.

As to the language, whereby said head can be positioned intermediate a ball and socket of a ball-and-socket joint; a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

With respect to claims 11, 13,17,22, 26, 31-35, the above combination of references discloses all the limitations as set forth and as best seen in the figures.

With respect to the claims 12,18,23,27, it is noted that the above combination of references did not teach of joint spacer having a thickness of about 31 millimeters; and, an extension extending 30 degrees away from the radius of curvature; as claimed by applicant. However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to reach an optimum value since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. In re Boesch, 617 F. 2d 272,205 USPQ 215 (CCPA 1980). It also has been held that where the general condition of a claim is disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. In re Aller, 105 USPQ 233.

With respect to claims 43-47, Rubin teaches all the limitations, except for a spacer means being offset from the head; as claimed by applicant. However, by replacing the head of Rubin with the curved head of Stryker, would obviously make the spacer means (16) offset from the head.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

4,600,005

07-1986

Hendel

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Pedro Philogene whose telephone number is (703) 308-


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2252. The examiner can normally be reached on Monday to Friday 6:30 AM to 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin P Shaver can be reached on (703) 308-2582. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Pedro Philogene
February 23, 2005


PEDRO PHILOGENE
PRIMARY EXAMINER